



In The United States Patent And Trademark Office

REPLY
BRIEF

Appl. Number: 09/978,215
Appl. Filed: 10/15/01
Applicant: Luis J. Rodriguez
Title: Self Sealing Letter Sheets (Formerly "Self Sealing Forms")
Examiner / GAU: Jes F. Pascua / 3727

RECEIVED
SEP 12 2003
TECHNOLOGY CENTER R3700

REPLY BRIEF**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Noted.
9/25/03

This is in response to Examiner's answer with mailing date of August 27, 2003.

I. Regarding Preliminary Items in Examiner's Answer**Item (2) Related Appeals and Interferences**

Appellant clarifies that there was no statement identifying any related appeal or interference, as there are no related appeals and interferences.

Item (3) Status of Claims

The status of claims reported by Examiner is incorrect. See 37 CFR 1.192 (c)(3) The status of claims in Appeal brief was correct.

While cancellation of Claim 60 was not entered, Appellant is not appealing claim 60. Therefore, claim 60 has no effect on this appeal.

Again, the correct status of claims is:

Claims 01-70 have been rejected.

Claims 01-44 have been cancelled.

Claims 45-70 are pending. *(This includes claim 60)*

Claims 45-59 and 61-70 are appealed. *(This excludes claim 60, as claim 60 is not appealed)*

Item (4) **Status of Amendments After Final**

Characterization by Examiner of the Status of amendments by appellant as incorrect is erroneous. Appellant reported that Amendment C had not been entered, and that a petition to the Director to reverse such ruling had been submitted and it was pending a decision. The statements by Appellant in the Appeal brief were correct.

Now that a decision has been rendered, it is more pertinent to state, as per paper 33 by the Director, regarding the After Final Action that:

- 1) All arguments and attachments submitted with paper 13 (entitled Amendment "C") related to original —**unamended**— claims 45-70 are entered. That is, except for the amended claims section (pages 3-20) and page 26, the entire paper 13 (Amendment "C") is entered in the record.
- 2) Amended claims 45, 49, 50, 53, 54, 57, 62, 67 and 68 are not entered.
- 3) Arguments submitted with paper 13 (entitled Amendment "C") related to amended claims 45, 49, 50, 53, 54, 57, 62, 67 and 68 are not entered.

The only arguments related to these claims are in page 26.

There is no Attachment or exhibit related to such claims.

On last paragraph of paper #33, the Director instructed Examiner to make sure that all

amendments in Amendments A and B are properly and physically entered into the Application.

Director also instructed Examiner to consider all arguments in Amendment C which relate to claims and specification prior to the final rejection.

A chart summarizing items entered is submitted on next page..

SUMMARY OF ITEMS IN THE RECORD

AMENDMENT A

WHAT IS ENTERED	WHAT IS NOT ENTERED
Everything	

AMENDMENT B

WHAT IS ENTERED	WHAT IS NOT ENTERED
Everything, Except Substitute Specification	Substitute Specification

AMENDMENT C

WHAT IS ENTERED	WHAT IS NOT ENTERED
Arguments, Attachments and Exhibits related to issues before final action, i.e.: <ul style="list-style-type: none">• Arguments on pages 21-25• Arguments on pages 27-76• Attachments 15-31• Exhibits A-E	<ul style="list-style-type: none">• Amendments to Specification (pages 1 and 2)• Amendments to Claims (pages 3-20)• Arguments about Amended Claims (page 26)• Affidavit 4

Item # (6) **Issues**

Examiner states: "The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:"

Then Examiner discusses some grounds of rejections of claims, which result incongruent and confusing, as Appellant did not present anything of that nature in the "**Issues**" section. It is noted that three officers subscribe the Examiner's answer.

Item # (7) **Grouping of Claims**

Examiner's grouping of claims is incorrect.

Po-se Appellant did not propose any grouping of claims different than the one established by default in O.A of 09/11/2003. The claims are grouped in just as many groups of two or more claims were rejected under the same grounds. Claims singularly rejected automatically stand or fall apart. Claim 60 is excluded of any consideration as claim 60 is not appealed.

Therefore, no statement by Appellant explaining the grouping is necessary.

Please, refer to 37 CFR 1.192

*Grouping of claims. For **each ground of rejection** which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.*

Thus, the grouping of the claims set forth in page 10, of Appeal Brief, was correct. As rejection of claims 45-53 under 25 USC 112 2nd para. was withdrawn, Appellant submits a revised chart reflecting the updated grouping on next page.

UPDATED Grouping of Claims

UPDATED to reflect Withdrawal of 35 112 rejection of claims 45-53 in Examiner's answer.

GROUPED CLAIMS	GROUND OF REJECTION	LOCATION IN SEPT. 11/02 O.A.
i) 45-49	35 U.S.C. 112. first paragraph for alleged lack of disclosure of a 'mono-sectional' body	Page 2, Section 4. Page 3, Section 5.
ii) 49	35 U.S.C. 112. first paragraph because 'mono-sectional' is allegedly new matter	Page 3, Section 5, second sentence.
iii) 68-70	35 U.S.C. 112. first paragraph for alleged lack of disclosure of a letter sheet having a repositionable adhesive, and a dry adhesive	Page 3, Section 7
iv) 45-47, 62-64 and 66	35 U.S.C. 102(b) as allegedly anticipated by Schieman	Page 5, Section 15
v) 45-47, 49-51, 53-55, 57, 58, 62-64, 66 and 67	35 U.S.C. 103(a) as allegedly unpatentable over Johnson in view of Wilbur or Schieman	Pages 5/6, Section 17
vi) 48, 52, 56, and 65	35 U.S.C. 103(a) as allegedly unpatentable over Johnson in view of Wilbur or Schieman and Stenner	Page 6, Section 18
vii) 59 and 61	35 U.S.C. 103(a) as allegedly unpatentable over Johnson in view of Wilbur or Schieman	Pages 6/7, Section 19

Item # (8) **Claims Appealed**

Examiner incorrectly modifies the status of appealed claims as it is Appellant's prerogative to determine which claims are appealed. Appellant, therefore respectfully restates that the appealed claims are 45-49 and 61-70. Claim 60 is not appealed.

Copying the text of claim 60 was unnecessary, as although cancellation of the claim was not entered, it is not appealed either.

See 37 CFR 1.192, (c):

(9) **Appendix.** *An appendix containing a copy of the claims involved in the appeal.*

Claim 60 is not involved in the appeal.

Item # (9) **Prior Art of Record**

Examiner lists Schieman 2,367,440, Wilbur 2,384,223, Johnson 3,027,067, and Stenner 5,607,100, as prior art, which Appellant disputes, as this is considered incorrect.

Only Johnson relates to a letter sheet, which is not self sealing, and it is different in structural terms, and therefore its extent as prior art is debatable.

Item # (10) **Grounds of Rejection**

The grounds of rejection of appealed claims indicated by Examiner are incorrect, because:

- 1) Claims 61-67 are not rejected under 35 USC 112, first para.
- 2) Claim 60 is not being appealed.

For a summary view of the Grounds of Rejection, please, refer to the "**UPDATED Grouping of Claims**" on page 6 of this Reply Brief, which shows the grouping of the claims just as they stand rejected.

II. New Issues

Examiner's answer with mailing date of August 27/2003, raises a number of new issues which clearly have an effect on this case, as follows:

- 1) A new Examiner, Mr. Jes F. Pascua has been assigned to this case.
- 2) All the arguments submitted by the new Examiner are new, either because they address an issue never before responded to, or because they are different than arguments by original examiner.
- 3) These two factors compound the documented history of unfair actions, events and circumstances in this case.
- 4) The new Examiner characterizes Appellant's references to Amendment C as "numerous". Examiner also characterizes petitions by Applicant as "numerous". (Examiner's answer, last page, third para.) These characterizations have an editorializing effect on the record, as they suggest that these references and petitions may be unwarranted. This suggestion needs to be addressed by Appellant, as follows:

- a) Amendment C, and all its attachments responded to all the issues in O.A. of Sept. 11/02, which were without any exception proven incorrect. Furthermore, Amendment C included proactive efforts to disprove the persistent contention by Examiner that the present invention is an envelope.

If the references to Amendment C are "numerous", it is only proof of the overwhelming uncontested evidence supporting the invalidity of the rejections, which progressively grew throughout the prosecution phase.

Original Examiner never addressed any of these "numerous" arguments. Not

even after he specifically requested that Applicant indicated the differences of invention with respect to References. (See O.A. of June 20/02, page 11, 2nd para.) The 'numerous' character of the arguments was never questioned during examination.

b) If there are "numerous" petition issues, it is simply due to the fact that first, there were "numerous" errors and contradicting actions by the Director's Office, as proven by the Office's reversal of its previous rulings, as follows:

- 1) Paper 21 dismisses petition to waive suspension of rules related to timeliness, under 37 CFR 1.183 alleging that no fee was submitted.
- 2) Paper 23 (*sua sponte*) vacated the decision of paper 21, to correct the error as the fee had been paid, and to re-rule.
- 3) Paper 15 granted entry of model
- 4) Paper 24 denied 'entry' of the already entered model **[SIC]**
- 5) Paper 27 again **[SIC]** denied entry of the already entered model.
- 6) Paper 31 reversed ruling of Papers 24 and 27
- 7) Paper 29 denied entry of already entered **[SIC]** Amendment B, fails to respond to some petitions while it addresses issues that were not petitioned. **[SIC]**
- 8) Paper 33 overruled paper 29, correcting its errors, granting some of the petitions, and dismissing others on timeliness technicalities.

And second, it was necessary to resubmit some petitions regarding supervisory authority, because in spite of an understanding reached by phone with the Director, and other factors reported in paper # 34 by Applicant, none of the petitions was ever considered on its merits. None of

the serious complaints, which include proven, undisputed misrepresentation on the record by original Examiner were ever considered, as per Petition of May 12/03, page 2, last two paragraphs; page 10, third paragraph (Item 12)) and as documented by Exhibit F.

The Director's Office opted to dismiss the petitions on timeliness technicalities, disregarding its full power and authority to waive them to impart justice.

Paper 25 by director, announced that Examiner Garbe was promoted to a 'Quality Review' board, in high contrast with the petitions that such paper dismissed on technicalities, in spite of the seriousness of the complaints presented. Appellant respectfully submits that such sequence of events, at least raises a question about the equity of the Director's office, as it would be—at best—very ironical to overrule on improper actions amounting to poor quality of examination an Examiner who had just been promoted to a 'Quality Review Board'.

- 4) The statement by Examiner that all claims 45-70 fall together is incorrect. This is of alarming gravity, and is further aggravated by the fact that Examiner perfectly well knows that claims 45-70 were alternatively rejected under different grounds, as reflected by Examiner's #(10) item "Grounds of Rejection". After such statement, with such devastating potential, pro-se Appellant respectfully brings to the Board's attention that whether or not Examiner's answer is in good faith becomes an issue.

The grouping of claims by Appellant was correct. Since rejections of claims 45-53 under 35 USC 112, second paragraph, was withdrawn by Examiner's Answer, a new chart reflecting the current grouping of claims is submitted on page 6 of this Reply Brief.

- 5) The Examiner's answer is partial and selective of the arguments it addresses. Most

of the arguments by Appellant remain undisputed. Notably, not one of the visual exhibits and attachments was addressed by Examiner. Particularly notable all of the arguments, and exhibits disproving the Original's Examiner's contention that Applicant focused on explaining "**What The Invention Is Not**" instead of "**What the Invention Is**" remain undisputed.

Equally significant, all the allegations by original Examiner that this invention is an envelope, that it has panels, etc., which drove this case to this lengthy prosecution including an RCE and this Appeal, were abruptly and completely abandoned. In fact, the new arguments on last para. of page 7 of Examiner's answer's amount to a concession that envelopes are not analogous to this invention.

This concession automatically establishes patentability over alleged prior art, as the rejections under 102(b) and 103(a) were based and argued on this erroneous premise. In O.A of Sept. 11/03 Examiner referred to the invention as an 'envelope' in three separate instances.

- 6) Withdrawal of rejection of claims 45-53 under 35 USC 112 2nd para. constitutes admission that the claims are "picture claims" as graphically demonstrated on page 39 of Amendment C. See Interview Summary by Applicant (**Exhibit F**), page 2, Section 4) (para. 1-5)
- 6) Last page, third para. of Examiner's answer indicates that the decision on petition regarding Amendment C is summarized in paper # 33. Consistent with paper 33, Appellant respectfully submits a summary of rulings regarding Amendment C in the form of a chart on page 4 of this Reply Brief.
- 7) A review of the History of the case obtained on Sep.03/03 via fax from the Office reveals that more than five and a half months elapsed between the time the Appeal Brief was filed, and the time it was forwarded to the Examiner.

III. Reply to 'Response to Argument'

(Examiner's Answer, page 5, 5th para.)

Examiner argues that the remark "that claim 45 and its dependent claims 46-49 fully complies with 35 USC 112" is 'opinion'; as if that is all that Appellant submitted.

That opinion is substantiated as a fact in the subsequent paragraphs, which Examiner opted to ignore.

See Appeal brief, page 11, (about middle of page), beginning with: "*See claims 1-22*"...

(Examiner's Answer, page 5, last para.)

Allegation that Appellant fails to address the rejection regarding "at least one" as a modifier of "mono-sectional" body is incorrect.

Appellant fully addressed this issue, both in "Amendment C", and in the Appeal brief. Please, refer to Appeal Brief, page 11, last line, and 5 first paragraphs of page 12.

Bottom-line:

Appellant disclosed "one" and "two" body embodiments, which validates the expression "at least one".

Among others, please refer to FIGS. 7A-7F which illustrate a letter sheet with one body.

Then, see FIGS, 24A-24N and 25A-25O, which respectively disclose two-way-self-sealing-mailers, having each two bodies (mailers).

(Examiner's Answer, page 6, 1st para.)

Allegation that Appellant fails to address the rejection regarding "at least one" in claim 49 is actually confusing, as such rejection (*first para. of page 3 of last O.A.*), encompassed claims 46-49, which is fully addressed along rejection of claim 45 in page 11 continued on page 12 of Appeal Brief. This had also been addressed in

Amendment C.

The only rejection of claim 49 alone relates to the phrase "at least one mono-sectional flap", which is fully addressed by Appeal Brief on pages 12 (bottom half) and page 13 (2 first paragraphs)

(Examiner's Answer, page 6, 2nd para.)

The allegation that Appellant is silent with respect to the rejection of claim 60 is moot, as claim 60 is not appealed.

(Examiner's Answer, page 6, 3rd para.)

Regarding rejection of claims 68-70 under 35 USC 112, first paragraph, new Examiner now resorts to the following statement: "Neither appellant's original specification nor arguments explicitly state the "repositionable adhesive" to mean "low tack adhesive"

Prosecution of this case has been closed. It appears that Examiner is trying to present a "new" new matter rejection, as this contention was never before presented.

In any event, the allegation is incorrect, and such incorrectness will be addressed later, as it appears more significant to first address the fact that this is simply a trivial and frivolous argument. This is not 'opinion'. It is the law:

MPEP 2173.05 (e) «...There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.»

It is just a matter of simple logic that the only way an adhesive can be repositionable is if it is Pressure Sensitive, and if it is of low tack properties.

As already stated, Examiner's statement is incorrect. Although it is not necessary that claims have a **literal** antecedent in the specification or that such literal antecedent be

indicated in the arguments, this was in fact established, as follows:

See paragraphs 1-4 of page 53 of paper entitled "Amendment C"

See Appeal Brief, page 4, 6th paragraph; in the "ISSUES" section, which examiner concurred with in his answer.

But, none of these considerations is even necessary, as Original Examiner admitted on the record that the repositionable adhesive 204 had been disclosed. See Summary of Interview by Applicant, **(Exhibit F)** page 3, para. 6-8.

(Examiner's Answer, page 6, 5th para.)

Examiner indicates that Appellant is silent regarding claim 60 being indefinite.

Again, as claim 60 is not appealed, there is no point in discussing it.

(Examiner's Answer, page 6, 6th para.)

The argument by the New Examiner that "the self sealing letter sheet" or "the self sealing form" occur in the preamble is also new, in contrast with arguments by Original Examiner alleging that Appellant had focused on "what the Invention is not" instead of "what the invention is", and that the invention was an envelope, etc.; (See O.A. of 09/11/2002, page 7, 2nd para.) and his request that Appellant pointed out the differences of the claimed invention with respect to the references (O.A. of June 20/02, page 11, 2nd para.), which prompted Attachments 11-14 and 15-31.

In any event, the new contention by new Examiner does not have any precluding effect. The new Examiner contends that "a preamble is generally not accorded any patentable weight, where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. (Then, a case is cited)

The above reasoning actually proves how improper the rejection is, since:

- 1) This is not a "general" abstract situation, but rather a very specific case.
- 2) **No** claim in this application recites any 'purpose' or 'intended use' in the preamble. (If at all, any 'purpose' or 'intended use' is recited, it is recited as a 'whereby' appendix at the end of the claim.)
- 3) What the term "Self Sealing Letter Sheet" or "Self Sealing Form" in the preamble does is to specifically recite what the invention IS, in clearly assertive terms, fully supported by the specification, imparting vitality and meaning to the body of the claim. Without it, the body of the claim does not have any meaning. Without it, no invention is defined. Please, see: MPEP 2111.02:

Weight of Preamble

"[A] claim preamble has the import that the claim as a whole suggests for it." Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim."

(Examiner's Answer, page 7, 2nd para.)

The new Examiner states: "The Examiner maintains that the body of Schieman is mono-sectional to the degree that the body is formed from a unitary sheet of material."

First, this statement is grossly incorrect and improper, as the term "maintains" entails a previous claim of such notion, which never occurred. Examiner never claimed that Schieman's body is mono-sectional *'because it is formed from a unitary sheet of material.'*

This appears to be an attempt by the new Examiner to now be his own lexicographer, which is a role reserved for applicants only, and worse yet, it is so doing after the fact.

And even worse yet, such notion is in radical conflict with the meaning of the elements in this case, and it is further in conflict with just plain logic.

This is further confusing, as such "unitary sheet of material" also provides the flap(s). So, in this retrospective definition by the new Examiner, the flap(s) is part of the body, and as a result, nothing actually gets 'defined' by the definition.

Moreover, by embracing this definition, new Examiner contradicts the original Examiner, who disputed the mono-sectional character of the invention's body, allegedly 'because it has panels'. See page 2, 5th and 4th lines from the bottom of O.A. of Sept. 11/2002.

Also, see O.A. of June 20 page 2, Section 3, particularly, the allusion "It appears that the two recited 'sections' are present regardless of whether the body is folded or not."

(Examiner's Answer, page 7, 3rd para.)

After absolute silence during Examination, Examiner refers to the features (Plural) that Appellant submits as the differences between current invention and the references, however only the "each flap" issue is addressed; which makes grossly misleading the acronym "i.e." as used by the Examiner.

Examiner claims that what appellant submits as argument, is not recited in the rejected claims; i.e., that "each flap needs to be in contact with the body, and remain in a temporarily fastened condition until sealing is desired" is not in the claim. That is incorrect. The argument is an interpretation of the claim, so the essence of the argument is in fact recited in the claim:

Claim 45) ... *d) at least one layer of adhesive, and at least one layer of adhesive inhibitor applied to said blank of a sheet material, in such a manner that when said at least one mono-sectional flap is in contact with said at least one mono-sectional body, said at least one layer of adhesive faces said at least one layer of adhesive inhibitor, whereby said at least one mono-sectional flap and said at least one mono-sectional body can be removably fastened to one another,*

It is perfectly clear that the meaning of the argument, i.e., that each flap needs to be in contact with the body, and remain in a temporarily fastened condition until sealing is desired, is recited in other words by the claim.

It appears that Examiner is suggesting that claims should be worded as arguments. That

is simply impossible, as there is no way Appellant could anticipate grounds of rejections, to argue them in advance in the claims.

All the other differences submitted remain undisputed.

Also regarding the 102(b) rejections, their validity is categorically disproved by the Examiner's admission that Schieman or Wilbur are not analogous art with a letter sheet (See page 7, 4th para. of Examiner's Answer), as a 102(b) rejection must be based on a reference, anticipating the claimed invention, by showing all its structural features.

(Examiner's Answer, page 7, 4th para.)

After absolute silence during prosecution, on page 7, last paragraph, of the answer, new Examiner discusses Appellant's argument that Schieman and Wilbur are non-analogous art with respect to Johnson. Then, new Examiner offers some reasoning to this newly submitted argument and cites a case.

First and foremost, this constitutes admission by the new Examiner that they are non-analogous.

The allegation that Schieman and Wilbur are reasonably pertinent to a particular problem with which Applicant was concerned, citing #6 of the list of the items in page 2 of specification, is an improper attempt at hindsight, which additionally fails to establish any equivalence of the problem solved by Schieman or Wilbur and this invention. The problem in Schieman and Wilbur's case is to 'seal an envelope', and the problems this invention solves are of a much wider scope, including among others: 1) to build a form, (so an envelope is obviated) and 2) to seal such self contained form. (See Specification, pages 4 and 5)

Examiner never satisfied his burden of establishing a prima facie case of obviousness, as Examiner proposes an incorporation of dry adhesive with release (page 6, first para. of O.A. of 09/11/2002) which does not serve any practical purpose, and which does not result in the invention, and even if it did, Examiner also fails to explain how or why the

references would lead anybody to such conclusion. (See also Appeal Brief, page 24, starting on 3rd para.)

Or how and why a person would determine which parts of Schieman or Wilbur are to be used, and which ones are not (for instance, the glue that keeps the container's panels together), and how the elements from Wilbur or Schieman will be extrapolated to Johnson and why.

There is no way to logically extrapolate the use of PSA from any of the cited envelopes to a letter sheet, as even if abstracted from the rest of the entire structures, there is no equivalence between the elements involved, regardless of any nomenclature coincidences or discrepancies. See Appeal Brief, page 18, paragraphs 4-7. Please, see Exhibits A-E. See Attachments 15 and 16. See Attachments 21, 22, 23, 24, 25, 26, 27 and 28.

It is further noted that up to this point, Examiner had contended that this invention was an envelope. Therefore the 103(a) rejections were based on that erroneous premise, and the switch in reasoning by the new Examiner proves that the original burden of proving a prima facie case of obviousness had not been satisfied, and as a result, that the rejection is invalid.

None of the arguments presented with the Response of Oct. 17/02 by Applicant were at all addressed by the Examiner. Regarding this issue, among other arguments, Appellant submitted the fact that there is no reason or motivation for such combination. Appellant demonstrated that Johnson actually teaches away from having this invention's features and that other references closer in structure to the sum of the references do not meet the claimed invention, proving a) a long felt need (please, see Affidavit 1, section I beginning on page 2, and its respective source/references); and b) failure by others who have actually produced a closer in structure device, yet have failed to arrive at the invention (please, see Affidavit 1, section II, beginning on page 6 and all the attachments referenced therein; especially ATTACHMENT 9)

(Examiner's Answer, page 8, 2nd para.)

New Examiner now argues that the method of forming the device is not germane to the issue of patentability of the device itself, which is a moot, non-responsive issue, because that is not Appellant's point. Appellant's point is simply that such difficulties teach away from any combination, as there is no reasonable expectation of success to combine Johnson's string and PSA interacting with a release substance (See appeal Brief, beginning on page 23, 2nd para. through end of page 24)

(Examiner's Answer, page 8, 3rd para.)

After absolute silence during prosecution, New Examiner's response regarding suitability of the invention for laser printers and other heat and friction generating machines is 'non sequitur'. Appellant does not argue that intended use establishes patentability, as suggested by Examiner on last para. of page 8 of Examiner's answer.

The argument by Appellant is that Johnson's tear string impregnated with dry adhesive, which is exposed at all times, will preclude the use of the form with any heat or friction equipment, and the point is that such limitation teaches away from combining Johnson with PSA + Release to obtain the present invention, as the compatibility with laser printers and other heat or friction machines of this invention is one of its purposes.

Furthermore, the allegation is moot as no claim recites any "intended use" as suggested by the Examiner.

In that same paragraph (page 8, last para.), Examiner also submits new arguments related to 'process of making' claims. This is a moot issue, as none of the claims is of that type. All the claims are 'product' or 'article' claims.

After absolute silence during prosecution, regarding the incompatibility of release and pressure sensitive adhesive in Johnson's case, on last para. of page 8, new Examiner unsupportedly alleges that appellant's arguments are opinion, which makes Examiner's statement an opinion, and further an incorrect one, since Appellant exhaustively demonstrated such incompatibility as a fact.

Please, refer to Appeal Brief beginning on 5th para. of page 21 thorough end of page 24. See Amendment C, pages 53-55.

The part where Examiner alleges that "fails to overcome the combination of the prior art as a whole" is not understood. Especially in light of the fact that the necessary burden of how and why such combination would take place was never satisfied by the Examiner.

In any event, Appellant exhaustively brought to the Examiner's attention in Response of Oct. 17/03 and again in Appeal Brief:

a) why such combination is not desirable, b) why such combination will not result in any useful product (let alone this invention), and c) the fact that after a long felt need, others have produced devices that are structurally closer to this invention, yet have failed to materialize it and to meet its structural and functional features.

Which along other arguments remain undisputed.

Examiner further incorrectly alleges that "there is nothing that precludes 'the incorporation of interactive release and pressure sensitive adhesive'"

Again, please, refer to Appeal Brief beginning on 5th para. of page 22 thorough end of page 24. These arguments were also submitted with paper of Oct. 17/02, and were not addressed by the Examiner. Also, see Amendment C, pages 53-55.

(Examiner's Answer, page 9, 2nd para.)

After an absolute silence during examination regarding the Appellant's dispute of the hypothetical combination of Schieman or Wilbur with Johnson—which remains un-established in terms of 'prima facie' case of obviousness—new Examiner now submits some abstract and stereotyped arguments that fail to address the issues in specific terms related to this case, as Appellant has. Please, see discussion about hypothetical combination of Schieman and Johnson beginning on page 16, last paragraph, through page 18, 3rd paragraph of this Reply Brief. This covers all possible combinations of Johnson with Schieman or Wilbur, because as established in Amendment C, Wilbur's first

embodiment is identical to Schieman's second embodiment. And Wilbur's second embodiment, having a flap with coatings on both sides, a fortiori denies any hypothetical combination.

(Examiner's Answer, page 9, 3rd para.)

The Affidavit of "long felt need" was never addressed during examination. New Examiner incorrectly states that "Appellant fails to show that the need has been a persistent one that was recognized by persons having ordinary skill in the art"

Please, refer to "Affidavit 1", beginning on page 2, 10th para. through page 8, 3rd. para. and all the references therein. Note, that the "Self Seal Mailer" by Avery Dennison Corp. was considered novel, as it displays a 'patent pending' indicia. Likewise, product disclosed by Pat 5,087,238 to Olson is commercialized by New England Business Services (NEBS) of Groton, MA. with the commercial name "Laser Taxi". These two companies by far exceed the standard of "ordinary skill in the art."

Also, see discussion of Tissot submitted by original Examiner as a precluding reference, and abruptly abandoned as such. (Amendment A, pages 25-27; and Attachment 6)

(Examiner's Answer, page 9, last para; page 10, 1st para.)

After an absolute silence during Examination, new Examiner selectively addresses one of the arguments submitted by Appellant regarding the triple combination of Johnson with Schieman or Wilbur plus Stenner, and incorrectly refers to Appellants position about Stenner as 'opinion'.

First, Examiner seems to disregard the legal fact that the burden was on Examiner to prove why and how the references can be combined, and how such combination would result in the claimed invention. Burden which was not satisfied other than by a vague stereotyped expression. Stenner's summary provided by Appellant establishes the radical distinctions between the references, and therefore, is a fact, not an

opinion. It disproves the notion that anybody would go to that art to look for a solution to an issue related to letter sheets.

The newly alleged by the new Examiner "desirability of Stenner to provide a plurality of forms in series" (page 10, 1st para. of answer) when combined with the other references, defies logic, as Stenner pieces are massively produced, "stuffed" and sealed at once. Hence, there is no need for a Pressure Sensitive Adhesive, or for a 'temporarily sealing' phase, and without it, there is absolutely no need whatsoever to use any type of release. (Please, see Amendment C, pages 53-55) Examiner also failed to explain how all of this would be done.

In any event, all of this is in essence moot, as Johnson and Stenner's configurations preclude to be built in continuous forms, adopting the PSA + release coatings. Since Examiner does not explain how the references are to be combined, let us consider both scenarios:

- 1) In the case of Johnson, the preclusion is due to the fact that since the form has flaps on its four sides, it is physically impossible to produce them in series because: first, both coatings (PSA and release) must be applied. After this is done, all flaps must be folded against the body to place the continuous forms in final condition, ready to be used. This will simply be impossible, regardless of the orientation of the web, because either flaps 6 and flaps 8, or flaps 7 and 9 will remain in an unfoldable condition along the perforation lines. The forms are not ready, and they can not be used. They do not result in the claimed invention. See specification, FIGS. 14's, 15's, 16, 17's and 18.
- 2) In Stenner's case, due to the necessary unfolded condition of 'composite sheets' or 'webs' 10 a similar situation, precluding the use of PSA in conjunction with release coatings occurs as discussed in Appeal Brief (page 27, 28, and first para. of page 29.).

(Examiner's Answer, page 10, 2nd para.)

After an absolute silence by original Examiner during the prosecution of the case, new Examiner now alleges that since "Johnson was not a secondary or 'teaching' reference, but instead the primary", the argument by Appellant that it teaches away from the invention is not persuasive.

This new argument by Examiner is of no legal effect, as both references are "teaching" since:

***"the prior art reference (or references when combined) must teach** or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." MPEP 2142.*

There is no discrimination about "primary" and "secondary" in the legal requirements for a prima facie case of obviousness.

Furthermore, since Johnson is never used in a 102(b) rejection (which is normally based on a stand-alone reference) while Schieman in fact is, it appears that Schieman (or Wilbur) are the "primary" reference, regardless of the order in the rejection. And in any event, the combination does not provide any reasonable expectation of success for production or use regardless of any order the references are cited.

(Examiner's Answer, page 10, 3rd para.)

Examiner refers to Paper 33 regarding decisions of the Director about Amendment C and Appellants references thereto, as well as Appellant's petitions. Applicant submitted a summary of such decisions in the form of a chart on page 4 of this Brief.

(Examiner's Answer, page 10, 4th para.)

Examiner states that for the arguments submitted, the rejections should be sustained.

Appellant respectfully replies that all the arguments in the Examiner's answer, are new. Some of which contradict or otherwise disprove previous Examiner's arguments. In any

event, none of the arguments in the Examiner's answer supports any of the rejections, and several actually clearly indicate allowability.

Very respectfully,

Luis J. Rodriguez

-----Applicant Pro Se-----

60 Fourth Street
South Orange, NJ 07079-1851
Tel. (973) 761-1300; Fax:(973) 761-6488

Date of Mailing: September 08, 2003

I hereby certify that this correspondence, including its attachments is being deposited with the United States Postal Service "EXPRESS MAIL TO ADDRESSEE" Service **ER064497027US** under 37 CFR 1.10 on the date indicated above, and is addressed to Mail Stop Appeal Brief-Patents; Commissioner for Patents; P.O. Box 1450, Alexandria, VA; 22313-1450

Luis J. Rodriguez, Applicant

Signed: 



09-09-03

AF
3100

Please type a plus sign (+) inside this box →

PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/978,215	
	Filing Date	10/15/01	
	First Named Inventor	Luis J. Rodriguez	
	Group Art Unit	3727	
	Examiner Name	Jes F. Pascua	
Total Number of Pages in This Submission	74*	Attorney Docket Number	

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Licensing-related Papers	<input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/> Stamped, Self Addressed Postcard
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	*Including this form, and postcard. Reply brief is in triplicate.	

RECEIVED

SEP 12 2003

TECHNOLOGY CENTER R3700

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Luis J. Rodriguez
Signature	
Date	March 07, 2003

CERTIFICATE OF MAILING	
I hereby certify that this correspondence including listed items is being deposited with the United States Postal Service with sufficient postage as Express Mail #ER064497027US, in an envelope addressed to: Commissioner For Patents, Mail Stop Appeal brief, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.	
Typed or printed name	Luis J. Rodriguez
Signature	
Date	September 08, 2003

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.